

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTIAN MIESCHER, DWIGHT CORMIER
and RIC QUELLETTE

Appeal No. 2004-0194
Application No. 09/571,606

ON BRIEF

Before KIMLIN, KRATZ and TIMM, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claim 16. Claims 14 and 15, the other claims remaining in the present application, have been allowed by the examiner. Claim 16 is reproduced below:

16. A rotary blade folder comprising:

two fold rollers; and

a folding cylinder, the folding cylinder including:

a cylinder body with an outer surface,

a set of tucking blades, the set of tucking blades being spaced axially apart from each other,

a grid-shaped expansion plate adjustable to change an effective diameter of the folding cylinder, the expansion plate having a first plurality of apertures spaced axially next to each other and a second plurality of apertures spaced axially next to each other and circumferentially spaced from the first plurality of apertures, the set of tucking blades fitting through the first plurality of apertures during a tucking operation so as to present a fold in a signature to the two fold rollers.

The examiner relies upon the following references as evidence of obviousness:

Mukai	4,936,561	Jun. 26, 1990
Kubota et al. (Kubota)	5,122,109	Jun. 16, 1992

Appellants' claimed invention is directed to a rotary blade folder of a printing press in which a continuous web is cut into signatures and folded. The rotary blade folder comprises a folding cylinder which in turn comprises an adjustable grid-shaped expansion plate having a first and second plurality of apertures. The first plurality of apertures is spaced axially next to each other, as is the second plurality of apertures. The first and second plurality of apertures are circumferentially spaced from each other. A set of tucking blades fits through the first plurality of apertures so as to present a fold in the web,

whereas the second plurality of apertures facilitates bending of the expansion plate and provides improved air flow.

Appealed claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mukai in view of Kubota.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. As a result, we concur with appellants that the examiner has failed to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejection.

There is no dispute that neither Mukai nor Kubota discloses a folding cylinder of a rotary blade folder comprising the presently claimed grid-shaped expansion plate comprising a first and second plurality of apertures. While the examiner relies on Kubota for disclosing a first and second plurality of apertures spaced axially next to each other, appellants properly note that "[t]he bands of Kubota are not a 'plate having a plurality of apertures' but rather are individually adjustable pairs of bands having a single aperture" (page 4 of principal brief, first paragraph). In response, the examiner concludes that:

[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Kubota's folding apparatus by having an expansion plate with a first plurality of apertures spaced axially next to each other, since it has been held that forming in one piece an article which has

formerly been formed in two pieces and put together involves only routine skill in the art.

(Page 4 of Answer, last paragraph). Hence, it can be seen that the examiner's rejection requires not only modifying Mukai, the primary reference, in view of Kubota's disclosure, but also requires the modification of Kubota itself. In any event, it is our opinion that while it may have been obvious, as a general proposition, to form in one piece an article that was known to exist in two pieces, there is simply no teaching or suggestion from the combined teachings of Mukai and Kubota to form the presently claimed grid-shaped expansion plate having a second plurality of apertures that are circumferentially spaced from the first plurality of apertures. Appellants' specification describes a specific purpose for the second plurality of apertures of the claimed expansion plate. The examiner has not explained how forming one piece from the individual bands of Kubota "clearly will indicate the expansion plate with a second plurality of apertures spaced axially next to each other and circumferentially spaced from the first plurality of apertures" (page 5 of Answer, second paragraph). It seems to us that any such indication proposed by the examiner emanates from an impermissible use of hindsight based on appellants' specification, not the teachings of the cited references.

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In conclusion, based on the foregoing, the examiner's
decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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PETER F. KRATZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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CATHERINE TIMM)	
Administrative Patent Judge)	

ECK:clm

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